REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1, 3-6 and 10-18 are currently pending in the application. No claim amendments are presented, thus no new matter is added.

In the Office Action, Claim 18 is rejected under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph; Claims 1, 3-6, 10-16 and 18 are rejected under 35 U.S.C. § 102(b) as anticipated by Ogura et al. (U.S. Pub. 2002/0010854, Ogura); and Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ogura in further view of Kobata et al. (U.S. Pat. 7,051,003, Kobata).

The Office Action rejects Claim 18 under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph, asserting that the claim "overlaps two different statutory classes of invention". Applicants respectfully traverse this rejection.

At p. 3, the Office Action asserts that Claim 18 is indefinite because it "claims both an apparatus and the method steps of using the apparatus". This, however, is not the case. Instead, Claim 18 recites a method in which various claimed steps of the method are performed by components of an image forming apparatus. More particularly, Claim 18 recites "a method... comprising" features such as "connecting ... the external apparatus to the image forming apparatus", "preparing a display", "registering an ID of the application", "presenting the display on the display unit" and "unregistering the ID". Claim 18, therefore, is directed to a method or process that is tied to a particular apparatus (an image forming apparatus) as required by *In re Bilski*, and does not claim a system or apparatus and a method for using it, which is the case in both *IPXL Holdings v. Amazon* and *Ex parte Lyell*.

Accordingly, Applicants respectfully request that the rejection of Claim 18 under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph, be withdrawn.

With regard to the position noted on p. 4 of the Office Action that the patentability of apparatus Claims 1, 3-6 and 10-16 "depends on the structure, not the use or purpose of that structure", Applicants note that MPEP § 2173.01 states, "Applicant may use **functional language**, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. For example, a motor is defined by what it does, not by the arrangement of magnets and windings of copper wire or the location of pistons and cylinders that may make up the motor. In another example, a PC may be programmed to perform any of a number of applications. The fact that the PC is capable of being so programmed does not mean that the tasks in the applications themselves carry no patentable weight.

Accordingly, as independent Claim 1 recites structural or functional features with respect to how each of the components are ***configured***, Applicants respectfully submit that each and every limitation recited in Claims 1, 3-6 and 10-16 should be given patentable weight.

Moreover, MPEP §2173.05(g) specifically states that "A functional limitation ***must be evaluated and considered***, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated

function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." *Id.* at 1118, 72 USPQ2d at 1006." (emphasis added).

Furthermore, the Office Action appears to assert that features of the claimed invention can be ignored as being "functional," in other words that the function cannot be relied upon to distinguish the prior art based on language found in MPEP §2114. However, the case law cited in this section as well as other controlling precedent does not support the conclusion that a claimed function can be ignored. In this regard, In re Schreiber, 128 F.3d 1473, 1477-78 44 USPQ 2d 1429, 1431-32 (Fed. Cir. 1999) (cited as authority in the noted MPEP §2114) does not support any theory that functional limitations can be ignored, rather this case requires that a reference structure used to reject a claim structure defined by what it does must *inherently* perform the claimed function. In this regard, it is well established that inherency requires the certainty that something will happen, not merely a possibility or even a probability that something may occur. See In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) and In re Oelrich, 212 USPQ 323, 326 (CCPA 1981).

Further discussion of functional limitations in MPEP §2173.05(g) that specifically treats the Swinehart decision (In re Swinehart 439 F.2d 210, 169 USPQ 226 (CCPA 1971)) mentioned in MPEP §2114 as noting that functional limitations defining structure by the function performed by that structure are valid claim limitations that this section instructs "must be evaluated and considered, just like any other limitation of the claim . . . ."

Therefore, Applicants respectfully submit that all features recited in Claims 1, 3-6 and 10-16 should be considered and given their full meaning.

The Office Action rejects Claims 1, 3-6, 10-16 and 18 under 35 U.S.C. § 102(b) as anticipated by Ogura. Applicants respectfully traverse this rejection as independent Claims 1 and 18 recite novel features clearly not disclosed by Ogura.

Independent Claim 1, for example, recites, in part, an image forming apparatus comprising:

> ... a relay unit configured to ... notify said display information controlling unit of ***a display that is to be presented on said display unit to indicate ongoing initialization of the application at the external apparatus until the application becomes operational*** when an input is received from a user attempting to use the application ...; and
>
> a registering unit configured to register an ***ID of the application in the software*** during the initialization of the application, and unregister the ID in the software when the external apparatus is disconnected from the interface unit.

Independent Claim 18, while directed to an alternative embodiment, recites similar features.

Turning to the applied reference, Ogura describes an image forming device capable of being operated in energy-saving mode. Ogura, however, fails to teach or suggest various features recited in amended independent Claims 1 and 18.

In rejecting the features directed to "the a relay unit configured to ... notify said display information controlling unit of a display that is to be presented on said display unit to indicate ongoing initialization of the application", p. 6 of the Office Action relies on Fig. 11 and paragraphs [0227] and [0364] of Ogura. Paragraph [0227] of Ogura describes that a CPU 102 in the image processing device carries out an initialization process after receiving electricity from the main power source 112 in energy-saving mode. When the CPU 102 receives text data in the format shown in Fig. 11, the CPU 102 determines a destination of data and a type of the data from the instruction signal or the text data. This cited portion of Ogura, therefore, merely describes a process of determining a type and destination of data, and does not relate to ***initialization of an application at an external apparatus***, as claimed. Moreover, this portion of Ogura does not relate to ***notifying a display information controlling unit of a display to be presented on a display unit to indicate***

ongoing initialization of the application at the external apparatus until the application becomes operational, as required by independent Claim 1.

Paragraph [0364] of Ogura describes that at each image-forming device, if the main switch is turned on, the main power source 61 is turned on and supplies electricity to the entire image-forming device. The CPU 21 of the personal interface 18 recognizes that the electricity is supplied to the entire image-forming device, and transmits a startup signal to the data communication device 7 by using the serial communication control unit 28. Thus, this cited portion of Ogura merely describes a startup operation performed at each image forming apparatus, and is in no way related to ***notifying a display information controlling unit of a display to be presented on a display unit to indicate ongoing initialization of the application at the external apparatus until the application becomes operational***, as required by independent Claim 1. More specifically, it is unclear how this cited portion of Ogura relates to notifying a display controller of a display to be presented, whatever, much less that such a display indicates an ongoing initialization of an application at an external apparatus.

Independent Claim 1 further recites "a registering unit configured to register an ***ID of the application in the software*** during the initialization ***of the application***, and unregister the ID in the software when the external apparatus is disconnected from the interface unit". In rejecting the above noted claimed features, p. 6 of the Office Action relies on paragraphs [0211]-[0214] of Ogura, noting the "ID code". These cited portions of Ogura describe a process in which each of the image forming devices 1-5 communicate with the central management device 6, and the central management device is capable of storing an ID code specifying one of the plurality of the image forming devices. Thus, the ID code in Ogura does not correspond to an ***ID of the application in the software***, nor is the ID registered ***during the initialization of the application***", as required by independent Claim 1.

Accordingly, for at least the reasons discussed above, Applicants respectfully request that the rejection of Claim 1 (and Claims 3-6 and 10-16, which depend therefrom) under 35 U.S.C. § 102 be withdrawn. For substantially similar reasons, it is also submitted that independent Claim 18 patentably defines over Ogura.

With regard to the rejection of Claim 17 under 35 U.S.C. § 103 as unpatentable over Ogura in view of Kobata, it is noted that Claim 17 depends from Claim 1, and is believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Kobata fails to cure any of the above-noted deficiencies of Ogura.

Accordingly, Applicants respectfully request that the rejection of Claim 17 under 35 U.S.C. § 103 be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1, 3-6 and 10-18 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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